

## **REMARKS**

### **Status of the Claims**

Claims 273 to 300 were pending. Applicants note with appreciation that the Restriction Requirement has been withdrawn and claims 287-292, 299 and 300 have been rejoined and examined. Claims 273 and 275 have been amended as suggested to clarify antecedent basis for the term "binding sites." Claims 293, 294 and 299 have been amended herein to specify that the DNA-binding domain is a zinc finger DNA-binding domain, as described throughout the specification as-filed. Claim 297 has been amended to provide proper antecedent basis for the recitation "polypeptide sequence." Thus, claims 273 to 295, 296, 297, 299 and 300 are pending as shown above.

### **Rejections Withdrawn**

Applicants acknowledge with appreciation withdrawal of the previous rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph as well as withdrawal of the rejections under 35 U.S.C. § 103(a) based on Dove and the obviousness-type double patenting rejection of claims 273-275, 282, 294, 296 and 297. (Office Action, paragraphs 11 to 14).

### **Information Disclosure Statement**

The Office Action indicated that the IDS filed with the application did not comply with 37 C.F.R. § 1.98(a)(2) in regards to citations B4-B8 on the grounds that these references could not be found in prior Application Serial No. 09/990,762. (Office Action, paragraph 5).

Applicants submit an IDS with references B4-B8 as previously submitted in the parent case (USSN 09/990,762). Applicants request that these references be considered by the Office and that the PTO/SB/08A form be initialed and signed indicating consideration of these references.

### **Specification**

The specification was objected to for failing to include commas between multiple sequence identifiers. (Office Action, paragraph 7). In addition, it was noted that the sequence GCGTGGGCG on page 5, appeared to lack a sequence identifier. (Office Action, paragraph 8).

As shown above, the specification has been amended to include commas between sequence identifiers at the appropriate locations, thereby obviating this objection. With regard to the sequence “GCGTGGGCG,” Applicants note that sequence identifiers are required only for nucleotide sequence of 10 or more base pairs. As this sequence includes only 9 nucleotides, a sequence identifier is not required.

### **35 U.S.C. § 112, 2<sup>nd</sup> Paragraph**

Claims 273-294, 296, 297, 299 and 300 were rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph as allegedly indefinite. (Office Action, paragraph 16). In particular, claims 273 and 275 were alleged to be indefinite because it was unclear as to the “a binding site” recited in the penultimate line. *Id.* Claim 280 was alleged to be unclear as to whether the same elements are recited as in claim 277. *Id.* Claims 293 and 294 were alleged to be unclear in reciting “DNA binding domain.” *Id.* Claim 297 was alleged to be unclear for lack of antecedent basis for the recitation “polypeptide.” *Id.* Finally, it was noted that there was no antecedent basis for the recitation “a DBD recognition element” in claim 299. *Id.*

Applicants thank the Examiner for the careful attention to the claim language and have amended claims 273, 275, 293, 294, 297 and 299 as suggested. In particular, claims 273 and 275 have been amended to recite “the one or more binding sites” in the penultimate lines; claims 293, 294 and 299 clarify that the DNA binding domain or DBD recognition element is a zinc finger DNA-binding domain; and claim 297 now recites “the polypeptide sequence.”

With respect to claim 280, Applicants note that this claim depends from claim 277 and further specifies that the activation tag is Gal11P and that Gal11P non-covalently interacts with a fusion polypeptide comprising the molecules recited in both claims 277 and 280.

Accordingly, in light of the foregoing amendments and remarks, withdrawal of the rejections under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph is in order.

### **Double Patenting**

Claims 273-275, 282, 293-298 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-5 of copending Application No. 10/915,233 in view of Jappelli et al. (Office Action, paragraph 18).

As previously noted, for a proper obviousness-type double patenting rejection, the Office must show that the conflicting claims are not patentably distinct from the reference claim(s). See, M.P.E.P. § 804(B), citing *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); and *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Indeed, 35 U.S.C. § 121 prohibits the use a divisional application filed as a result of a Restriction Requirement, as a reference against other divisional applications filed from the application in which the Restriction Requirement was issued.

Here, copending application no. 10/915,233 is a divisional of USSN 09/990,762 (which is a CIP of 09/858,952) and includes only method claims as required by a Restriction Requirement in the parent case. (See, 23-way Restriction Requirement in 09/858,952, mailed January 16, 2004). By contrast, claims 273-275, 282, 293-298 are composition claims. Therefore, the Patent Office has determined these claims to be patentably distinct from the claims in copending application 10/915,233.

Moreover, the claims in the conflicting application are of different scope than the claimed methods. In particular, the claims in copending Application No. 10/915,233 require the use of two reporter genes and a weak zinc finger DNA-binding domain. Instant claims 273-275, 282, 293-298 contain no such requirements.


Thus, the Office has not shown that these claims are patentably indistinct from the composition claims as pending. Therefore, the obviousness-type double patenting rejection should be withdrawn.

**CONCLUSION**

Applicants submit that the claims are in condition for allowance and request early notification to that effect. If the Examiner has any further issues or wishes to discuss any of the foregoing, he is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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